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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,523	01/21/2004	Koji Hagiya	2185-0716P	1106

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BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER

NGUYEN, CAM N

ART UNIT PAPER NUMBER

1754

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/760,523	<b>Applicant(s)</b> HAGIYA ET AL.	
	<b>Examiner</b> Cam N. Nguyen	<b>Art Unit</b> 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on January 24, 2005 (an RCE).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Status of an RCE Application***

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 01/24/05 has been entered.

### ***Response to Amendment***

2. Applicants' remarks and amendments, filed on January 24, 2005, have been carefully considered. Claims 1-2, 7, & 8 have been amended.

Claims 1-8 are currently pending in this application.

### ***Claim Objections***

3. Claims 7 & 8 are objected to because of the following informalities:

- A. In claim 7, line 1, "The catalyst" should be changed to --The oxidation catalyst--.
- B. In claim 8, line 1, "The catalyst" should be changed to --The oxidation catalyst--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112 (Second Paragraph)***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-6 & 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it would appear that applicants claiming an oxidation catalyst composition comprising (i) a composition containing at least one of components (a), (b), (c), and (d); and (ii) an organic solvent. It is unclear to the examiner as to whether the oxidation catalyst composition contains component (ii), which is an organic solvent, in the final product because the Examples in applicants' specification shows that the organic solvent, such as t-butanol, is used during the process of making the oxidation catalyst.

***Claim Rejections - 35 USC § 102(b)/103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Young (US Pat. 3,893,947).

Young discloses a catalyst consisting essentially of a refractory inorganic oxide support and a hydrogenation component, said hydrogenation component consisting essentially of at least one Group VI-B metal constituent selected from the group consisting of molybdenum, tungsten and catalytically active compounds thereof, etc. (see col. 7, ln 22-28). The Group VI-B metal compound used to prepare the catalyst includes oxides, sulfides and thermally decomposable compounds of molybdenum, tungsten, or mixture thereof (see col. 7, ln 31-34). The catalyst is heat treated or calcined (see col. 3, ln 11-33), thus provides for a catalyst dehydrated.

Product-by-process limitations in the claims have been noted. While the catalyst of the reference is not made by the same process, the catalyst made is the same as being claimed. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP* 2113.

As concern with claim 2, it is considered the claim is met by the teaching of the reference because the "organic solvent" being claimed would not be considered part of the final product since it is used during the process of making the catalyst composition and would be evaporated upon heat treating or in the calcination step.

***Response to Applicants' Arguments***

8. Applicants' amendment/response filed on January 24, 2005 has been fully reconsidered, but not deemed persuasive in view of the new ground of rejection above.

***Citations***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form attached. All references are cited for related art.

***Conclusion***

10. Claims 1-8 are pending in the application. Claims 1-8 are rejected. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn  
April 29, 2005

*cnn*

*Cam Nguyen*  
CAM N. NGUYEN  
PRIMARY EXAMINER  
*AV-1754*